

REMARKS

The Office Action dated January 13, 2004, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this amendment, claims 3 and 6 have been amended. No new matter has been added. Claims 1-8 are currently pending in the application with claims 1, 2, 7, and 8 having been allowed. Claims 3-6 are respectfully submitted for consideration.

The Applicants wish to thank the Examiner for allowing claims 1, 2, 7 and 8, and indicating allowable subject matter in claim 4.

Claims 3-6 are rejected under 35 U.S.C. § 103(a) over Kato, et al. (U.S. Patent No. 6,053,785, "Kato"), in view of Nanami et al. (U.S. Patent No. 5,366,401, "Nanami"). To the extent that this rejection remains applicable to the claims currently pending, Applicants hereby traverse the rejection, as follows.

The Applicants respectfully submit that the combination of Kato and Nanami fails to disclose or suggest the claimed features of the invention. Claims 3 and 6, as amended recite, "a swivel shaft for steering of the outboard engine . . . said case member being connected to said swivel shaft." Claims 3 and 6 as amended further recite, "said catalytic converter is disposed in a space surrounded by said case member and an exhaust passage-defining member so as to be held by the exhaust passage-defining member, the exhaust passage-defining member being detachably coupled to said connection of the case member to permit the exhaust gas to flow thereinto." In contrast, Kato fails to disclose or suggest at least the feature of an exhaust passage-defining member being detachably coupled to the connection of the case member, as claimed. There is no disclosure or suggestion in Kato as to how or where any element comparable to the exhaust passage-defining member is

detachably coupled to the connection of the case member. As such, Kato fails to disclose the arrangement of elements as recited in claims 3 and 6.

Nanami fails to cure the deficiencies in Kato with respect to claims 3 and 6, as Nanami does not disclose or suggest at least a catalytic converter disposed in a space surrounded by the case member and an exhaust passage-defining member so as to be held by the exhaust passage-defining member, the exhaust passage-defining member being detachably coupled to said connection of the case member to permit the exhaust gas to flow thereinto. As such, the combination of Kato and Nanami fails to disclose or suggest the features of the invention as recited in amended claims 3 and 6.

With respect to the previously presented features of the invention, the Office Action took the position that Kato disclosed each of the limitations of claims 3 and 6, except for the detachable lid. Nanami was cited for curing this deficiency. The Applicants have deleted this limitation from the claims.

However, the Applicants submit that the references, either singly or in combination, do not teach or suggest all of the limitations of claim 3. Applicants submit that neither Kato, nor Nanami, nor the combination thereof discloses or suggests at least the limitation of a connection into which said exhaust passage opens, the connection being formed in a sidewall of the case member, as recited in claim 3.

The Office Action took the position that the extending section 88 of Kato was formed in a sidewall of the lower unit portion 15. See page 3 lines 4-5 of the Office Action. However, as can be seen in Figures 5-7 of Kato, the extending section 88 is disposed apart from the lower unit portion 15 and separated therefrom by the exhaust guide outlet passage 82. As such, the extending section 88 cannot be

formed in any portion of the lower unit portion 15 of Kato.

Nanami fails to cure this deficiency in Kato as Nanami similarly fails to disclose or suggest at least the feature of a connection into which said exhaust passage opens, the connection being formed in a sidewall of the case member, as claimed in claim 3, as amended.

For at least this reason, it is submitted that claim 3 is allowable over the cited prior art. As claim 3 is allowable, Applicants submit that claims 4 and 5, which depend from allowable claim 3, are likewise allowable. For similar reasons, Applicants submit that claim 6 is allowable over the cited prior art.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references

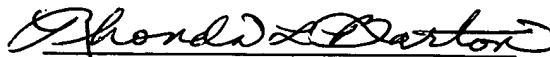
to evidence the desirability of these advantages in the disclosed structure. Accordingly, the combination of Kato and Nanami fails to disclose each and every element of the claimed invention and the combination of references further fails to provide the critical and non-obvious advantages provided by the invention.

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention over the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number indicated.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300 **referencing attorney docket no. 107348-00219.**

Respectfully submitted,



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